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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/732,530	12/08/2000	Flavio M. Manduley	F-157	4426
919	7590	11/18/2005	EXAMINER	
PITNEY BOWES INC. 35 WATERVIEW DRIVE P.O. BOX 3000 MSC 26-22 SHELTON, CT 06484-8000			FISHER, MICHAEL J	
			ART UNIT	PAPER NUMBER
			3629	
DATE MAILED: 11/18/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/732,530

Applicant(s)

MANDULEY, FLAVIO M.

Examiner

Michael J. Fisher

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-11,21,22 and 29-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-11,21,22 and 29-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 and 3, rejected under 35 U.S.C. 103(a) as being unpatentable over Belson et al (3,644,806) or Riley (3,917,048) or Kondo (4,971,466).

In regard to claims 1 and 3 either Belson et al ('806) or Riley ('048) or Kondo ('466) disclose a digital printing system/method in which a mechanism engages/holds the substrate while a digital print head prints one or more characters/symbols by printing as a series of rows/columns of dots. In these systems, after each row/column of dots is printed on the substrate, the engaging/holding mechanism disengages/releases the substrate and the substrate is appropriated moved/advanced relative to the printhead by a predetermined distance as indicated by an appropriate signal from a sensor. After the signal indicates that the substrate has been moved the predetermined distance of at least the width of a row/column of dots, the engaging/holding mechanism once again is applied to the substrate so as to prevent the substrate from moving while the next column/row of dots is being printed. This process is repeated until the control system

Art Unit: 3629

indicates that all of the row/columns of dots that form all the characters/symbols to be printed on the substrate have been printed on the substrate.

Belson, Riley or Kondo do not, however, teach a third mechanism responsive to the displacement. It would be inherent that they ensure that the print head lines up in the proper place to ensure that the printing is even. It is well within the purview of one of ordinary skill in the art to duplicate parts that do the same function (*St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8).

Claims 5 & 6 are rejected under 35 U.S.C. § 103(a) as being clearly anticipated by either Riley (3,917,048) or Kondo (4,971,466).

In regard to claims 5 & 6, either Riley ('048) or Kondo ('466) that the advancement means is a roller and the holding mechanism includes a latch which engages the teeth of a gear connected to the advancement means.

Claims 7-11, 21,22 & 29-33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Belson et al (3,644,806) or Riley (3,917,048) or Kondo (4,971,466) as applied to claims 1-3, 12-17 & 23-27 above and further in view of obvious modifications.

In regard to the type of system that uses the printer as recited in claims 7-9, 21,22 and 28, since there are many different systems that use printers and the systems of either Belson et al ('806) or Riley ('048) or Kondo ('466) describe a printer that could be used to print any data/information on a substrate, it would have been obvious to one of ordinary skill at any suitable system/device/method that could control the printer of either Belson et al ('806) or Riley ('048) or Kondo ('466) could use the printer of either Belson et al ('806) or Riley ('048) or Kondo ('466) absent applicant's showing of new and unexpected results from using a particular type of system with the printer of either Belson et al ('806) or Riley ('048) or Kondo ('466).

In regard to the type method/system used to provide relative movement between the printhead and substrate as recited in claims 10 & 11, since the systems of either Belson et al ('806) or Riley ('048) or Kondo ('466) require a relative movement between

the printhead and the substrate, it would have been obvious to one of ordinary skill at any suitable system/device/method that would provide the required relative movement between the printhead and substrate could be used absent applicant's showing of new and unexpected results from using a particular type of system/device/method that would provide the required relative movement between the printhead and substrate. Note that the Court has held that manual activity is equivalent to automatic activity when the end result is the same, for as the Court has stated it is not invention to broadly replace manual activity with an automatic activity that accomplishes the same result, (In re Venner and Bowser, 120 U.S.P.Q. 192 @ 194 (CCPA, 1958)).

In regard to the type substrate as recited in claims 29 & 30, since the systems of either Belson et al ('806) or Riley ('048) or Kondo ('466) require a substrate to receive the information to be printed, it would have been obvious to one of ordinary skill at any suitable type of substrate that could receive the information to be printed could be used absent applicant's showing of new and unexpected results from using a particular type of substrate to receive the information to be printed.

In regard to the nature of the information that is printed on the substrate as recited in claims 31-33, since the systems of either Belson et al ('806) or Riley ('048) or Kondo ('466) require information to be printed on a substrate, it would have been obvious to one of ordinary skill at any suitable type of information to be printed on the substrate could be used absent applicant's showing of new and unexpected results from using a particular type of information that is to be printed on the substrate.

Response to Arguments

Applicant's arguments with respect to the rejection under 35 USC 101 and the objections to the drawings have been fully considered and are persuasive. The rejection under 35 USC 101 and the objections to the drawings has been withdrawn.

Applicant's arguments filed 3/16/05 with respect the rejection under art have been fully considered but they are not persuasive. As discussed above, adding a third

Art Unit: 3629


mechanism for completing a task that printers do inherently would not make the instant invention patentably distinct.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Fisher whose telephone number is 571-272-6804. The examiner can normally be reached on Mon.-Fri. 7:30am-5:00pm alt Fri. off.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MF 
11/14/05


JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600